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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: EX. EDMUND H. LEE
FRANK M. SIMONUTTI, et al) METHOD OF MAKING A GOLF BALL
Serial No. 09/760,431) PRODUCT WITH A COVER MADE FROM
Filed: January 12, 2001) FAST-CURING REACTION INJECTION
) MOLDED POLYURETHANE
) ART UNIT 1732

REPLY

In response to the Office Action mailed July 2, 2004, applicants respectfully traverse the requirement for election. The Examiner has grouped the claims into Group I, comprising claims 1-19, and Group II, comprising claim 20. However, claim 20 is a product by process claim. The process steps are identical to the process steps of method claim 16. Although the Examiner states that the product as claimed can be made by another and materially different process such as casting or compression molding, the product as claimed is made by mixing first and second reactants which form a thermoset reaction mixture. The thermoset reaction mixture can be properly molded only by the reaction injection molding process and cannot be satisfactorily cast or compression molded. Accordingly, the golf ball described by the product by process claim 20 cannot be made by casting or compression molding. As stated in MPEP 806.5(f), if applicant convincingly traverses the requirement for election,

the burden shifts to the Examiner to document a viable alternative process or product, or withdraw the requirement.

Still another reason for withdrawing the requirement for election is applicants' request that an interference be declared between this application and Patent No. 6,290,614. Claims 16 and 20 correspond to claims 1 and 8 of Patent No. 6,290,614 except for limited differences relating to temperatures as described in the Preliminary Amendment which was filed on September 19, 2002. Claims 17-19 correspond to claims 3, 5, and 6 of the '614 patent except for slight temperature differences in application claim 18 and patent claim 5. The '614 patent issued with both method claim 1 and the product by process claim 8, which evidences a conclusion by the PTO that the method claim and the product by process claim are not subject to restriction. Further, in order to have all of the interference issues decided in the same application at the same time, product by process claim 20 of this application should be examined with application claim 16 so that a single interference can be declared between the process claims and the product by process claim of this application and the '614 patent.

In the event that the requirement for election is not withdrawn, applicants elect the claims of Group I, claims 1-19. Within Group I, applicants elect the species of forming a cover on a golf ball wherein a golf ball component is positioned within the molded cavity. The claims readable thereon are claims 1-12 and 16-19.

Respectfully submitted,

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